

**REMARKS**

Claims 1, 3 and 5-7 are all the claims pending in the application. Claim 1 has been amended to incorporate the subject matter of claims 2 and 4, which have been canceled. New claims 5-7 have been added based on, for example, pages 11-12 and 16-17 of the specification.

The specification has been amended to correct typographical errors and the abstract have been amended.

Entry of the above amendments is respectfully requested.

Initially, the Examiner objects to the specification. In view of the amendments to the specification and abstract, it is submitted that the objection has been obviated. Accordingly, withdrawal of the rejection is respectfully requested.

**I. Response to Rejection of Claims 1-4 under 35 U.S.C. § 112, second paragraph**

Claims 1-4 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Applicants respectfully traverse the rejection.

The Examiner asserts that in claims 1-2, the range of modulus of elasticity is indefinite as the claims provide no temperature limitations.

To meet the requirements of § 112, second paragraph, the claims must be sufficiently definite for one to reasonably determine their scope. MPEP § 706.03(d).

It is submitted that no temperature limitations need be provided. In addition, the present specification discloses that the tensile modulus of elasticity is measured according to JIS K7127. Accordingly, it is submitted that one of ordinary skill in the art would understand the meaning and scope of claim 1, and thus it is definite.

With respect to claim 3, the Examiner asserts that it is indefinite because of the phrase "in such a way" and because it does not recite a thickness of the film, which would inherently affect the transmittance of the range of wavelength of light.

Claim 3 has been amended to replace "in such a way" with "wherein". With respect to the thickness of the film, it is submitted that there are other factors that affect the transmittance of light than film thickness and that the lack of thickness does not render the claim indefinite. In this regard, MPEP 2173.04 states "that the breadth of a claim is not to be equated with indefiniteness". *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). Thus, every aspect that would affect the transmittance need not be recited in the claim. Accordingly, it is submitted that one of ordinary skill in the art would understand the meaning and scope of the claim, and thus it is definite.

In view of the above, withdrawal of the rejection is respectfully requested.

**II. Response to Rejection of Claims 1-3 under 35 U.S.C. § 102(b)**

Claims 1-3 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Sugino et al. (JP 2003-313330).

Applicants respectfully traverse the rejection.

Claim 1 is directed to a motor vehicle brake disc antirust film comprising a surface substrate film having a tensile modulus of elasticity of 220 MPa to 2200 MPa and a pressure-sensitive adhesive layer on one surface of the surface substrate film, wherein the pressure-sensitive adhesive layer has a thickness of 1 to 300  $\mu\text{m}$  and the surface substrate film has a thickness of 20 to 200  $\mu\text{m}$  and the surface substrate film is a polyethylene resin film comprising a mixture of a low density polyethylene resin having a density of 0.910 to 0.940  $\text{g/cm}^3$  and a high density polyethylene resin having a density of 0.945 to 0.960  $\text{g/cm}^3$  in a ratio of 30 to 95

parts by mass of the low density polyethylene resin relative to 100 parts by mass of the mixture.

Sugino discloses a polyolefin resin laminate film which comprises a substrate film of polyolefin resin and a coated film containing an acryl-modified urethane resin laminated to at least one surface of the substrate film of polyolefin resin, a ratio of a tensile modulus of elasticity (JIS K7127) of the coated film to a tensile modulus of elasticity (JIS K7127) of the substrate film is from 1 to 4.5. Also, Sugino discloses that a tensile modulus of elasticity of the polyolefin resin substrate film is 200 to 900 MPa.

However, the surface substrate film for a motor vehicle brake disc antirust film of the present invention does not have a coated layer containing an acryl-modified urethane resin.

In addition, Sugino discloses that the preferable substrate film of polyolefin resin comprises a homopolypropylene, a random polypropylene and at least one member selected from the group consisting of polyolefin thermoplastic elastomer, hydrogenated styrene-butadiene copolymer rubber and low density metallocene polyethylene having a density of  $0.900 \text{ g/cm}^3$  or below.

In contrast, the surface substrate film of the present invention is a polyethylene resin film comprising a mixture of a low density polyethylene resin having a density of  $0.910$  to  $0.940 \text{ g/cm}^3$  and a high density polyethylene resin having a density of  $0.945$  to  $0.960 \text{ g/cm}^3$ . Thus, Sugino does not disclose the claimed surface substrate film of claim 1.

Furthermore, Sugino discloses that, as prior art, films of polyvinyl chloride resin have been used as adhesive films (tapes) for medical care or industry uses and ornamental adhesive films (tapes) such as a sticker and marking film aiming at attachment on signboard and several kinds of parts, since the films of polyvinyl chloride resin is excellent in flexibility, scratch

resistance and weatherability. However, Sugino does not disclose that the film can be used for a motor vehicle brake disc antirust film.

For at least the above reasons, it is submitted that Sugino does not anticipate claim 1 since it fails to disclose each and every element of claim 1.

Moreover, the effects of the present invention is that the antirust film is not peeled off when a motor vehicle is being transported on a carrier car or when a completed motor vehicle is being subjected to a running, and the staining of the adherend is not caused when the antirust film is peeled off from the adherend, as demonstrated by the Examples in the present specification. Since Sugino does not mention motor vehicle brake disc antirust films, Sugino does not disclose the effects of the present invention nor would one of ordinary skill in the art expect such effects based on the disclosure of Sugino.

For at least the above reasons, it is respectfully submitted that claim 1 is patentable over Sugino.

In addition, claim 3 and new claims 5-7 depend from claim 1, and thus it is respectfully submitted that these claims are patentable for at least the same reasons as claim 1.

Accordingly, withdrawal of the rejection is respectfully requested.

**III. Response to Rejection of Claims 3-4 under 35 U.S.C. § 103(a)**

Claims 3-4 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sugino in view of Endo et al. (US 6,872,447) and in light of the evidence as provided by Petrie ("Handbook of Adhesives and Sealants").

Applicants respectfully traverse the rejection.

Claim 3 depends from claim 1, and thus it is respectfully submitted that claim 3 is patentable for at least the same reason as claim 1.

In addition, it is submitted that Endo does not make up for the deficiencies of Sugino. Endo discloses a surface protective pressure-sensitive sheet comprising a three-layered film composed of a layer (A), a layer (B), and a layer (C) superposed in this order and a pressure sensitive adhesive layer formed on the layer (C), wherein the layer (A) comprises at least 60 wt. % of polyethylene based on the whole weight of the layer (A), the layer (B) comprises at least 50 wt. % of polypropylene polymer based on the whole weight of the layer (3), and the layer (C) comprises at least 10 wt. % of hydrogenated styrene/diene copolymer based on the whole weight of the layer (C). Endo further discloses that, as prior art, sheets of polypropylene have been used as surface-protective pressure-sensitive sheet which is adhered to a surface of upper paint film coated on a surface of a body of automobile for protecting the surface of upper paint film, since the sheets of polypropylene is excellent in strength of the substrate, bending strength and heat resistance. However, the sheets of polypropylene after long-term outdoor exposure caused chalking, and when the sheets of polypropylene was peeled off from the body of automobile, staining on the body of automobile was caused by white powder from the sheets of polypropylene.

Thus, Endo does not disclose a motor vehicle brake disc antirust film nor make up for the deficiencies of Sugino.

In view of the above, withdrawal of the rejection is respectfully requested.

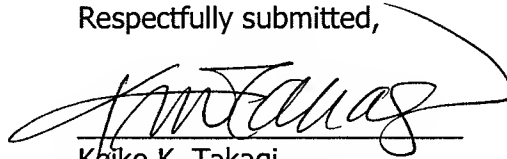
#### **IV. Conclusion**

For the foregoing reasons, reconsideration and allowance of claims 1, 3 and 5-7 is respectfully requested.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Keiko K. Takagi', written over a horizontal line.

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